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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,391	02/11/2004	Mitchell A. Altman	BIGTOE.003A	3924
20995	7590	05/17/2005		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER HOLLOWAY III, EDWIN C	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,391

Applicant(s)

ALTMAN, MITCHELL A.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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EXAMINER'S RESPONSE

1. In response to the application filed 2-11-04, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claim 8, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102 & 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Enomoto (US 5128667). Regarding claim 20, Enomoto discloses a method of effecting a function of a remotely controlled device including pointing a universal remote device 1 in the direction of (directed toward) the remotely controlled device in col. 3 lines 25-32 and col. 5 lines 42-56. The remote device includes a database of encoded signals for effecting control of a plurality of different device in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. Actuating an actuator (operating/depressing keys 2/3) to cause emitting of the encoded signals from the database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. Emitting the encoded signals by an emitter 82 is disclosed in col. 6 lines 54-68. Regarding claim 22, emitter 82 is an infrared LED in col. 6 lines 59-60. Regarding claim 23, pointing at a second device and repeating the actuating and emitting steps is

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disclosed in col. 5 lines 57-66. Regarding claim 23, the function includes OFF in col. 5 line 48.

7. Claims 21 and 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) as applied above in combination with Fridley (US 6005486). Regarding claim 21, Enomoto discloses transmitting the signal 3 times, but Fridley discloses transmitting a sequence or cluster of signals only once for eliminating a selection switch very rapid operation. See col. 9 line 48 - col. 10 line 9 and col. 12 lines 16-34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto the emission of the cluster only once as disclosed in Fridley for rapid operation. Regarding claim 26-28, repeating the operation to reverse the function between ON and OFF is disclosed in col. 12 lines 49-57 of Fridley and it would have been obvious to have included this operation in Enomoto because the "ON or OFF" function in Enomoto suggests this toggle operation and col. 12 lines 49-57 of Fridley states that this is common in TV codes. Regarding claims 29-31, Fridley includes 40 ms (less than 1/10 sec or 100 ms) delay between command in col. 19 lines 12-22 of Fridley and would have been obvious in the combination for rapid operation and is suggested by Enomoto disclosing only 0.6 ms between adjacent bits in col. 4 lines 50-55.

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8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) as applied above and further in view of Vanderpohl (US 6366328). Regarding claim 25, Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control. Vanderpohl discloses a television remote control device and method that is a CIP of the Fridley Patent and includes a control signal clusters for plural devices with a mute function cluster. See the abstract and col. 13 lines 28-47. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the mute function cluster of Vanderpohl in the combination applied above to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto.

9. Claims 1-2 and 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430). Regarding claim 1, Enomoto discloses a universal remote control device 1 for effecting a function of a remotely controlled device including actuator (buttons or keys 2/3) to cause emitting of encoded signals from a database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. The database of encoded signals for effecting control of a plurality of different device in the form

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of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. An emitter 82 to emit the encoded signals is disclosed in col. 6 lines 54-68. Enomoto does not expressly disclose a housing or no more than 1/2 second between each encoded signal. Emmons discloses a remote control for plural devices with a circular housing with buttons and multiple light emitting diodes for omnidirectional transmission of control signals, so the remote need not be pointed or have line of sight to the controlled device. Se col. 1 line 49 - col. 2 line 7 and col. 2 lines 27-49. Fridley discloses transmitting a sequence or cluster of signals with 40 ms (less than 1/10 sec or 100 ms) delay between command in col. 19 lines 12-22. Regarding claim 1, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto the housing Emmons to allow operation without accurate pointing or line of sight and it further would have been obvious to have included the 40 ms delay of Fridley for rapid operation that is suggested by Enomoto disclosing only 0.6 ms between adjacent bits. Regarding claim 2, the function of Enomoto includes OFF in col. 5 line 48. Regarding claims 4-6, although Enomoto shows 3 devices, the limitations of 5, 10 or 20 devices would have been obvious in view of the reference to "several devices" in col. 6 line 9 of Enomoto and because there is structure in the

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universal remote device to provide claimed number of controlled devices nor is there any criticality to the specific numbers claimed. Regarding claims 7, the controlled devices are television sets in col. 4 line 4 line 9 of Enomoto. Regarding claims 9-14, the circular housing of Emmons generally resembles a smiley face with a buttons 22a,b in the general area of the nose and multiple emitters 50 generally in the area of the eyes. Regarding claim 15, emitter 82 of Enomoto is an infrared LED in col. 6 lines 59-60. Regarding claims 16 and 17, the 40 ms delay applied to claim 1 is less than 1/10 second.

10. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Vanderpohl (US 6366328). Regarding claim 3, Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control. Vanderpohl discloses a television remote control device and method that is a CIP of the Fridley Patent and includes a control signal clusters for plural devices with a mute function cluster. See the abstract and col. 13 lines 28-47. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the mute function cluster of Vanderpohl in the combination applied above

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to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto.

11. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Shim (US 6078270). Shim discloses a remote controller with a sequence of consecutive commands for controlling different device such as a TV and VCR in response to a single key press in col. 4 lines 5-43 for simplified operation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the VCR control of Shim in the combination applied above for simplified operation that is suggested by Enomoto disclosing video devices in addition to televisions in col. 1 line 26 and col. 2 line 51.

12. Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Redford (US 5624265). Discloses simplified remote with a single button for single function for use by a child that would have been obvious in the combination applied above to allow use by a child.

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13. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Herweck (US 5731763). Herweck discloses a TV remote controller with a key chain housing in fig. 3A and col. 6 line 41 - col. 7 line 3 that would have been obvious in the combination applied above to allow small size

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rumbolt (US 4703359) and Griesau (US 6507306). Disclose universal remote controls.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.


Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff.

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Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
5/15/05


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635